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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,600	09/02/1999	SHINICHI KANEMATSU	35.C13795	4211

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EXAMINER

PARK, CHAN S

ART UNIT PAPER NUMBER

2622

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/388,600	<b>Applicant(s)</b> KANEMATSU, SHINICHI	
	<b>Examiner</b> CHAN S PARK	<b>Art Unit</b> 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>3/10/05</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                 |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/9/04 has been entered.

### ***Response to Amendment***

2. Applicant's amendment was received on 8/9/04, and has been entered and made of record. Currently, **claims 1-40** are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

4. The corrected or substitute drawings were received on 8/19/04. These drawings are acceptable.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant regards as his/her invention.

Evidence that claim 1, fails to correspond in scope with that which applicant regard as the invention can be found in the reply filed 8/9/04 wherein on page 23. In that paper, applicant has stated "image data obtained by scanning an original document at a first image processing apparatus is printed at a second image processing apparatus", and this statement indicates that the invention is different from what is defined in the claim because the first operating instruction, which examiner originally interpreted as an scanning instruction, is an instruction for the different image processing apparatus, which examiner originally interpreted as a printer, according to the claim (cited in the input means). It is unclear as to whether the image process, which corresponds to the first operating instruction, is processed by the image processing apparatus. If the image processing apparatus does not process the image process corresponding to the first operating instruction, it is further unclear as to how the first authentication means determines whether the first operating instruction, which now is processed by the different apparatus, is authorized for the user. Are both the first instruction and the second instruction for the different image processing apparatus? Does the image processing apparatus include the first authentication means for determining the authorization even when the image processing apparatus does not

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process the actual image processing corresponding to the first operating instruction? Is the applicant claiming that the image processing apparatus does not perform any image processing corresponding to either the first or second operating instruction? It is uncertain as to which of the two image processing apparatuses performs the first operating instruction and the second operating instruction.

Further, regards to claims 3-5, the applicant claims that a scanner is a part of the image processing apparatus. The applicant also claims that the first operating instruction is or can be an instruction for printing image data. It is questionable as to whether at least one of the first or second operating instructions has any relationship with the scanner. Doesn't at least one of the first or second operating instructions instruct the scanner to scan an image from the image processing apparatus? If not, what does the second operating instruction instructs the different apparatus to process when the first operating instruction is an instruction for printing, storing, or transmitting the data by the different apparatus?

Further, regards to claims 8-10, the applicant seems to claim, in claim 6, that the first operating instruction is for the different image processing apparatus (interpreted to be a scanner in this case). If so, does the first operation instruction also instruct to print, store, or transmit image data read by a scanner function of the different apparatus? Then, what does the second operating instruction instruct the image processing apparatus to perform?

Further, specifically regards to claim 4, examiner initially understood the two operating instructions to be the instructions for the image processes. If at least one of

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the instructions is an instruction for storing the image data in storage of the different apparatus, where is the image processing of the image data performed? Is the applicant claiming that storing of the image data is an image process of the image data?

Further, regards to claim 5, is the applicant acknowledging that the facsimile transmission inherently performs an image process such as a conversion of the image data to a facsimile data? If so, doesn't the image processing apparatus perform the conversion? It is uncertain as to what kind of an image process is performed at the different apparatus in response to the instruction.

With respect to other independent claims 6, 11, 16, 21, 26, 31 and 36, arguments analogous to those presented for claim 1, are applicable.

With respect to other dependent claims 8-10, 13-15, 18-20, 23-25, 28-30, 33-35 and 38-40, arguments analogous to those presented for claims 3-5, are applicable.

**Upon either amending or not amending the claims, the examiner respectfully requests the applicant to clearly point out where in the Specification and the drawings such features and the limitations as claimed are disclosed.** It would greatly help the examiner to better take a decision on patentability.

6. Claims 1-6, 7-11, 13-16, 21, 26, 28-31, and 36 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, 11, 16, 21, 26, 31, and 36 recite the limitation "said apparatus" cited in the registration means. There is insufficient antecedent basis for this limitation in the

claims. It is uncertain as to whether said apparatus is referring to the image processing apparatus or the different image processing apparatus.

Claims 2-5, 7-10 recite the limitation "an apparatus according to claim 1". There is insufficient antecedent basis for this limitation in the claims. It is uncertain as to whether the apparatus is referring to the image processing apparatus or the different image processing apparatus.

Examiner suggests using "first image processing apparatus" and "the second image processing apparatus" instead of "image processing apparatus" and "different image processing apparatus", respectively.

Claims 13-15, 28-30 recite the limitation "the operating instruction". There is insufficient antecedent basis for this limitation in the claims. It is uncertain as to whether the operating instruction is referring to the first operating instruction or the second operating instruction.

7. For the examining purpose, the examiner interprets that the first operating instruction is for the scanning operation performed by the image processing apparatus and the second operating instruction is for the printing, storing, or transmitting operation performed by the different image processing apparatus.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 11-20, and 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. U.S. Patent No. 6,115,739 (hereinafter Ogawa) in view of Lee U.S. Patent No. 6,628,413.

8. With respect to claim 1, Ogawa discloses an image processing apparatus (scanner 22 in fig. 6), which performs an image processing service provided by a first operating instruction about image processing (scanning) and a second operating instruction about image processing in association with a different image processing apparatus accessible across a network (figs. 6 & 7), comprising:

registration means for registering in advance predetermined registration information for a user who is authorized to use said apparatus (col. 4, lines 27-29);

input means (operator panel) for use by the user to enter user information and the first operating instruction for the different apparatus (col. 4, lines 3-4 and 22-30);

first authentication means for employing the predetermined registration information registered by said registration means and the user information entered by the user at said input means to determine whether the first operating instruction is authorized for the user (col. 4, lines 22-30); and



transmission means for, based on results obtained by said first authentication means, transmitting to the different apparatus the second operating instruction and the user information entered at said input means (figs. 6 & 7).

Ogawa, however, does not disclose expressly second authentication mean for obtaining from the different apparatus results of an authentication process, performed for the user information received from said transmission means, to determine whether the second operating instruction is authorized for the user on the different apparatus and determination means for employing the results obtained by said second authentication means to determine whether the user is to be permitted to use the image processing service.

Lee, the same field of endeavor of the network authentication system, discloses a different image processing apparatus (Java printer 110) comprising:

receiving means for receiving the user information and a second operating instruction (printing instruction) from an image processing apparatus (col. 4, lines 31-42);

authentication means for determining whether the second operating instruction is authorized for the user on the different apparatus (col. 4, lines 31-42); and

transmitting means for transmitting to the image processing apparatus results of an authentication process and notifying whether the user is authorized to use the different image processing apparatus (col. 4, lines 31-42).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the network printer of Lee with the network image processing service provided by the scanner of Ogawa.

The suggestion/motivation for doing so would have been to determine whether the user is authorized to use both the image processing apparatus and the different image processing apparatus from the image processing apparatus.

Therefore, it would have been obvious to combine Ogawa with Lee to obtain the invention as specified in claim 1.

9. With respect to claim 2, Ogawa discloses the image processing apparatus, wherein the predetermined registration information and the user information each includes at least a user ID and a password (col. 4, lines 22-30).

10. With respect to claim 3, Ogawa discloses the image processing apparatus, further comprising:

scanner means for reading a document (scanner 22 in fig. 6);

wherein at least one of the first operating instruction and the second operating instruction is an instruction for printing image data read by said scanner means using a print function of the different apparatus (printer 23 in fig. 6 & col. 5, lines 35-54).

11. With respect to claim 4, Ogawa discloses the image processing apparatus, further comprising:

scanner means for reading a document (scanner 22 in fig. 6);

wherein at least one of the first operating instruction and the second operating instruction is an instruction for storing, in a predetermined area, image data read by said

scanner means using a storage function of the different apparatus (file server 21 in fig. 6 & col. 4, lines 22-41).

12. With respect to claim 5, Ogawa discloses the image processing apparatus, further comprising:

scanner means for reading a document (scanner 32 in fig. 7);

wherein at least one of the first operating instruction and the second operating instruction is an instruction for transmitting, to a predetermined destination, image data read by said scanner means using a facsimile transmission function of the different apparatus (fig. 7 & col. 6, lines 3-23).

13. With respect to claim 11, 16, 26, 31, arguments analogous to those presented for claim 1, are applicable. Refer to figs. 4 & 5 of Ogawa for the registration table.

14. With respect to claims 12, 17, 27, and 32, arguments analogous to those presented for claim 2, are applicable.

15. With respect to claims 13, 18, 28, and 33, arguments analogous to those presented for claim 3, are applicable.

16. With respect to claims 14, 19, 29, and 34, arguments analogous to those presented for claim 4, are applicable.

17. With respect to claims 15, 20, 30, and 35, arguments analogous to those presented for claim 5, are applicable.

Claims 6-10, 21-25, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Ogawa.

18. With respect to claim 6, Lee discloses an image processing apparatus (Java printer 110) that performs an image processing service provided by a first operating instruction and a second operating instruction about image processing in cooperation with a different image processing apparatus accessible across a network, comprising:

registration means for registering, in advance, predetermined registration information for a user who is permitted to use said apparatus (col. 4, lines 35-38);

reception means for receiving user information and the second operating instruction (printing instruction) for said apparatus, both of which are entered by the user at the different apparatus on the network (col. 4, lines 30-38);

authentication means for employing the predetermined registration information registered by said registration means and the user information received by said reception means to determine whether the user is an authorized user (col. 4, lines 30-38); and

determination means for employing results obtained by said authentication means to determine whether the second operating instruction received by said reception means is to be accepted (col. 4, lines 30-38).

Lee, however, does not disclose expressly that the second operating instruction is received after the first operating instruction is authenticated to be performed on the different apparatus.

Ogawa, the same field of endeavor of the network authentication system, discloses a different image processing apparatus for determining whether the user is authorized to perform the first operating instruction (scanning instruction) on the different apparatus and when it is determined that the user is authorized to use the different apparatus, it sends the print data to a network printer to perform the second operating instruction, which is the printing operation. Read the argument presented for claim 1.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the network printer of Lee with the network image processing service provided by the scanner of Ogawa.

The suggestion/motivation for doing so would have been to determine whether the user is authorized to use both the image processing apparatus and the different image processing apparatus from the image processing apparatus.

Therefore, it would have been obvious to combine Ogawa with Lee to obtain the invention as specified in claim 6.

19. With respect to claim 7, Lee discloses the image processing apparatus, wherein the predetermined registration information and the user information each includes at least a user ID and a password (col. 4, line 34).

20. With respect to claim 8, the combination of Lee and Ogawa discloses the apparatus of claim 6, further comprising:

printing means for outputting data to a printer (fig. 3 of Lee and fig. 6 of Ogawa),

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wherein at least one of the first operating instruction and the second operating instruction is an instruction for employing said printing means to print image data read by a scanner function of the different apparatus (fig. 6 of Ogawa).

21. With respect to claim 9, the combination of Lee and Ogawa discloses the apparatus of claim 6, further comprising:

storing means for storing data (file server 21 in fig. 6 & col. 4, lines 22-41 of Ogawa),

wherein at least one of the first operating instruction and the second operating instruction is an instruction for employing said storing means to store image data read by a scanner function of the different apparatus (file server 21 in fig. 6 & col. 4, lines 22-41 of Ogawa).

22. With respect to claim 9, the combination of Lee and Ogawa discloses the apparatus of claim 6, further comprising:

facsimile transmission means for transmitting data by facsimile (fig. 7 & col. 6, lines 3-23 of Ogawa),

herein at least one of the first operating instruction and the second operating instruction is an instruction for employing said facsimile transmission means to transmit, to a predetermined destination, image data read by a scanner function of the different apparatus (fig. 7 & col. 6, lines 3-23 of Ogawa).

23. With respect to claims 21 and 36, arguments analogous to those presented for claim 6, are applicable.

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24. With respect to claims 22 and 37, arguments analogous to those presented for claim 7, are applicable.

25. With respect to claims 23 and 38, arguments analogous to those presented for claim 8, are applicable.

26. With respect to claims 24 and 39, arguments analogous to those presented for claim 9, are applicable.

27. With respect to claims 25 and 40, arguments analogous to those presented for claim 10, are applicable.

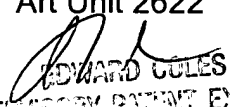
**Conclusion**

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

csp  
March 11, 2005

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